



UNITED STATES PATENT AND TRADEMARK OFFICE

AT
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/442,489	11/18/1999	BERT VOGELSTEIN	01107.78817	5944
7590	05/03/2004		EXAMINER	
BANNER & WITCOFF LTD ELEVENTH FLOOR 1001 G STREET NW WASHINGTON, DC 200014597			VANDERVEGT, FRANCOIS P	
			ART UNIT	PAPER NUMBER
			1644	

DATE MAILED: 05/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/442,489	VOGELSTEIN ET AL.
	Examiner F. Pierre VanderVegt	Art Unit 1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 09 February 2004.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____
 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____

DETAILED ACTION

Claims 2-8 have been canceled.

Claim 1 is currently pending and is the subject of examination in the present Office Action.

Prosecution in this application was closed on September 18, 2002 in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213. However, in view of the defective reissue declaration and the resultant ground of rejection as set forth below, prosecution is hereby reopened.

Reissue Applications

1. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

The reissue declaration fails to comply with 37 CFR § 1.175(b)(1), which states:

(b)(1) For any error corrected, which is not covered by the oath or declaration submitted under paragraph (a) of this section, applicant must submit a supplemental oath or declaration stating that every such error arose without any deceptive intention on the part of the applicant. Any supplemental oath or declaration required by this paragraph must be submitted before allowance and may be submitted:

- (i) With any amendment prior to allowance; or
- (ii) In order to overcome a rejection under 35 U.S.C. 251 made by the examiner where it is indicated that the submission of a supplemental oath or declaration as required by this paragraph will overcome the rejection.

In the amendment filed February 9, 2004, Applicant submitted an amended paper copy of the sequence listing and an amended version of the computer readable form (CRF). Upon processing the CRF, the STIC Systems Branch found a number of errors in the sequence listing and corrected the errors. Review of the paper copy of the sequence listing by the Examiner showed that the errors in the CRF were not present in the paper copy and that the amended paper copy was properly underlined and bracketed as required by 37 CFR § 1.173.

Because the amended paper copy of the sequence listing was correct as filed on February 9, 2004 and the CRF was correct as corrected by the STIC Systems Branch, the **entire amendment filed February 9, 2004 has been entered**.

However, because the CRF as filed contained errors that were not present in the paper copy of the sequence listing as filed, Applicant's statement under 37 CFR § 1.821(f) that the

Art Unit: 1644

paper copy of the sequence listing and the CRF are identical is defective because the paper copy and the CRF were not identical at the time of filing the statement. Accordingly, a new statement under 37 CFR § 1.821(f) is required. The new statement should state "the sequence listing information recorded in computer readable form filed February 9, 2004 as subsequently corrected by the STIC Systems Branch of the USPTO is identical to the written (on paper or compact disc) sequence listing as filed on February 9, 2004."

Also, because the corrections to the CRF were made by the STIC Systems Branch were made after Applicant's reissue declaration filed September 16, 2003 in accordance with 37 CFR § 1.175, the corrections made to the CRF are not covered by the reissue declaration. In fact NO amendment to the specification made after September 16, 2003 is addressed by the reissue declaration filed on that date. Accordingly, the reissue declaration filed September 16, 2003 is defective and a new reissue declaration/oath is required.

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

2. Claim 1 is rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

Art Unit: 1644

provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-8 of copending reissue Application No. 09/983,543. Although the conflicting claims are not identical, they are not patentably distinct from each other because the preparation of antibodies specific for APCs of SEQ ID NO: 2 or 7 as recited in claim 1 of the instant application constitute an anticipatory species of the preparation of antibodies which specifically bind to mutant forms of the APCs of SEQ ID NO: 2 or 7 because an antibody to SEQ ID NO: 2 or 7 may also be capable of binding the mutant proteins and there is no indication that cross-reactivity cannot occur [claims 2-8 of '543 application].

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

4. No claim is allowed.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to F. Pierre VanderVegt whose telephone number is (571) 272-0852. The examiner can normally be reached on M-Th 6:30-4:00; Alternate Fridays 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (571) 272-0841. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

F. Pierre VanderVegt, Ph.D. *P*
Patent Examiner
April 30, 2004

Christina Chan
CHRISTINA CHAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600